

**Application No.** : 09/671,761  
**Filed** : September 26, 2000  
**Office Action Date** : July 19, 2004  
**Response Date** : October 18, 2004

## **REMARKS**

The foregoing amendments and the following remarks are responsive to the July 19, 2004 Office Action.

### **Summary of Office Action**

Claims 1-16 are pending in the present application. In the July 19, 2004 Office Action, the Examiner rejected Claims 1-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,449,767 to Russell M. Krapf and Bradley S. Masters ("the '767 patent"). The Examiner acknowledged that the present application and the '767 patent have a common inventor and indicated that the "rejection" . . . might be overcome by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention 'by another,' or by an appropriate showing under 37 CFR 1.131."

### **Summary of Amendments to Correct Claim Dependencies**

During the preparation of this response, errors in the claim dependencies were noted. The errors were apparently caused by a problem with automatic claim numbering and cross reference generation. By the foregoing amendments, the errors in the claim dependencies of Claims 6-8 and 13-16 are corrected so that the dependent claims have the proper antecedent bases in the respective claims from which they depend.

### **Response to Rejection**

Applicants respectfully disagree with the Examiner's rejection because the rejection is not supported by the disclosure of the '767 patent. In particular, the '767 patent does not disclose or suggest a system which provides a viewer with a unified menu that displays three distinct choices of program content.

The present application discloses and claims a method and a system that display a menu of viewing choices. The viewing choices include at least one of the first plurality of display contents (e.g., content that was selected for recording by a preference engine based on the profile

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of a viewer), at least one of the second plurality of display contents (e.g., content that was recorded based on a selection made by the viewer), and at least one of the third plurality of display contents (e.g., broadcast programs that are currently available during a viewing session and that are selected by the preference engine based on the viewer's profile). As discussed in the specification, this unique menu of viewing choices enables a viewer to use a single menu to select content to watch during a particular viewing session. In particular, the single menu allows the view to select from currently available broadcast content and from both types of recorded content instead of having to switch between multiple menus in order to decide which content is available during the viewing session.

Applicants have amended independent Claims 1 and 12 herein to clarify that the menu of viewing choices includes at least one of each of the three types of available display contents. As stated above, the '767 patent does not disclose or suggest a single menu that displays the three types of viewing choices.

As set forth in the attached declarations, the subject matter disclosed and claimed in the present application was conceived and reduced to practice by Bradley S. Masters and William P. Price. Mr. Masters is also named as a co-inventor in the '767 patent with Russell M. Krapf. The claims of the '767 patent are not directed to the inventions claimed in the present application. To the extent that the Examiner maintains that the '767 patent discloses or suggests any subject matter claimed in the present invention, Applicants respectfully submit that any such subject matter was derived from the inventors of the subject matter claimed in the present application. Thus, the subject matter on which the Examiner bases the rejection under 35 U.S.C. § 102(e) was derived from the Applicants herein and cannot be relied upon by the Examiner to support the rejection.

#### **Discussion of Declarations Under 37 CFR § 1.132**

Applicants are submitting herewith the *Declaration of Bradley S. Masters Under 37 CFR § 1.132*, the *Declaration of William P. Price Under 37 CFR § 1.132*, and the *Declaration of*

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*Russell M. Krapf Under 37 CFR § 1.132.* The declarations present the facts that support the foregoing discussion.

In view of the accompanying declarations and the foregoing discussion, Applicants respectfully submit that the '767 patent must be withdrawn as a reference with respect to the inventions claimed in the present application.

#### **Request for Withdrawal of Rejection and Allowance of Claims**

Applicants respectfully request the Examiner to withdraw the '767 patent as a reference and to pass this application to the issue process with Claims 1-16 as presently pending.

#### **Request for Telephone Interview**

If any issue remains unresolved after consideration of this paper, Applicants respectfully request the Examiner to call the undersigned attorney of record in order to discuss and resolve any such issues. The Examiner may call the undersigned at 949-721-2849 (direct) or at the general office telephone number listed below.

Respectfully submitted,  
Attorney for Applicants

Dated: OCTOBER 18, 2004

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